

## REMARKS

Claims 1-57 are currently remain in the application. Claims 1, 14 and 15 have been amended. Claims 58-103 have been cancelled without prejudice to further prosecution. Claim 104 has been added.

Applicant inadvertently did not list all pending claims in the previous office action as required by new amendment format procedure. An office communication notifying the applicant of this defect was sent July 11, 2003. This amendment corrects the defect noted in the office communication of July 11, 2003.

### *Rejections under 35 U.S.C. § 103*

The Examiner rejected claims 1-22, 24-27, 29-41, 48-53 and 55 under 35 U.S.C. 103 (a) as being unpatentable over Walker et al. (US Patent No. 6, 379, 247) as applied to claim 1 or 15 in view of Cumbers (US Patent No. 6, 142, 876). The rejection is respectfully traversed.

Examiner states, “*Walker does not teach implementing the system in a mechanism or automatically determining that the patron has begun an activity for which player-tracking points accrue. Cumbers teaches implementing the system in a mechanism (i.e., slot machine) and automatically determining that the patron has begun an activity for which player-tracking points accrue.*” Applicant adds that Cumbers teaches a face recognition system.

In response to Applicants arguments, Examiner states, “*Applicant argues that Cumbers teaches away from the present invention because Cumbers gathers player-tracking information and starts a player tracking session. While this is true, Cumbers is not relied upon for these features. Cumbers stands for the proposition that comping systems may be implemented on a gaming machine. Examiner does not rely on a gaming machine. Examiner does not rely on any of Cumbers' comping system.*”

First, the applicant reasserts that Cumbers teaches away from the present invention. Applicant wishes to respectfully point out to the Examiner that to establish a *prima facie* case the Examiner is not allowed to pick and choose from the prior art only the parts that the Examiner considers pertinent but must consider all of the teachings of the prior art. In the MPEP section 2145 on teaching away it states, “*prior art must be considered in its entirety, including disclosures that teach away the claims, (also 2141.02)*” It further states, “*it is improper to combine references where the references teach away from their combination.*”

The present invention comprises limitations, such as recited in claim 1, where the mechanism is capable of awarding the player tracking points to the patron without receiving one of identification information, account information and combinations thereof from the patron.

Cumbers explicitly requires identification information from the player (facial recognition) to automatically determine that the player has begun an activity for which player accrues the points and to award the points. Thus, the Applicant reasserts that the combination is improper. Further, Applicant asks how Examiner's proposed system will award the player tracking points without receiving identification information? Cumbers teaches that to automatically determine that the patron has begun the activity for which player tracking points accrue identification information from the player is required. The MPEP 2143.01 states "*proposed modification cannot render the prior art unsatisfactory for the intended purpose or change the principle of operation of a reference.*" It is seems to the Applicant that awarding the player tracking points without receiving identification information would change the principle of operation of the device in Cumbers since it would have to operate without receiving identification information for the combination to work.

In addition to the arguments cited above, the Examiner has put forth arguments in regards to the suggestion and motivation for automation. Examiner's suggests automation of Walker's method as applied to a slot machine would be more profitable because slot machines do not require excessive dealer intervention. First, applicant's present invention is not limited to slot machines. Second, Applicant asks what modifications to Walker is the Examiner actually proposing? The MPEP section 706.2(j) (page 700-31 Eighth Edition) states: "*After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter and (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.*

Automation is a concept, or as stated by the Examiner a proposition (Examiner states, "*Cumbers stands for the proposition that comping systems may be implemented on a gaming machine.*"), but not an actual modification to the reference in Walker that will teach the claimed invention. Walker teaches a device that is manually operated by a dealer at a card table. The device in Walker already performs some tasks automatically such as performing addition.

Applicant asks how does the Examiner propose to modify the device in Walker to automatically detect that the player at the card table has begun an activity for which player tracking points accrue? Will it use facial recognition such as in Cumbers? Then, Applicant asks, for the modification that the Examiner proposes, to supply a motivation for the suggested modification. Walker does not provide a teaching or suggestion that his described device and method needs to be automated. Applicant respectfully requests that if the Examiner suggests a proposed modification, that the Examiner provides a reference that teaches that there is a difficulty with the device described in Walker or some other motivation that warrants the proposed modification. Therefore, for at least these reasons Walkers, Cumbers or the combinations of Walkers and Cumbers can't be said to render obvious the inventions as recited in claims 1-22, 24-27, 29-41, 48-53 and 55 and the objection is believed overcome thereby.

The Examiner rejected claims 42, 43, 54, 56 and 57 under U.S.C. 103 (a) as being unpatentable over Walker et al. and Cumbers as applied to claim 36, and in further view of Burns (US Patent No. 6, 048, 269). The rejection is respectfully traversed.

Claims 42, 43, 54, 56 and 57 recite the limitation “issuing to the game player a loyalty program instrument designed or configured to store the awarded loyalty points wherein the gaming machine issues the loyalty program instrument to the game player without receiving identification information from the game player.” As described above, for example with respect to claim 36, Cumbers teaches away from this limitation. Burns describes identifying a player using an identification card to determine the amount of time and/or money spent by the player (see Col. 6, 1. 56-57). Thus, Burns also teaches away from the present invention. Thus, applicant asserts that the combination is improper.

Further, Examiner’s assertions require that the devices in Burns be modified to read instruments storing loyalty point instruments. The Examiner states, “*Burns teaches a device that reads tickets. The fact that the tickets described in Burns are different from those described in Walker makes no difference-a ticket is a ticket.*” Applicant respectfully disagrees with this statement by the Examiner and asserts that what is read on the ticket does make a difference. The present invention describes reading instruments with loyalty points and the capability to validate and combine the loyalty points stored on the tickets. Applicant believes Examiner may be applying impermissible hindsight. MPEP 2145 states, “*any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary in the art at the time the claimed invention was made and does not include knowledge gleaned from applicant’s disclosure.*” Walker teaches printing a ticket (328), which may input by a cashier. Applicant asks how the Examiner arrives at a mechanism that can read, validate, and combine instruments with loyalty points other than by using the Applicant’s disclosure? None of the references has a teaching suggesting such capabilities except for the Applicant’s disclosure.

Establishing *prima facie* obviousness is more than looking at the prior art and identifying mechanisms that could be used to reproduce the Applicant’s invention. The Examiner must reconstruct the Applicant’s invention from the prior art including proposing modifications and teachings suggesting those proposed modifications using what is taught in those references and generally known in the skill of the art without the benefit using of what the Applicant has disclosed. If the only reason the Examiner has made the proposed modification is based upon the teachings of the Applicant’s disclosure then the Examiner is using impermissible hindsight. In the present case, the Applicant respectfully asks the Examiner to provide a teaching from the prior art that teaches or suggests a mechanism that reads, validates and combines instruments that stores loyalty points. Applicant again asks where is this taught or suggested in any of the references cited by the Examiner? Further, where is there a teaching in Walker that suggests or provides a motivation that the ticket in Walker should be read by a mechanism and not by the

cashier? Therefore, for at least these reasons, Walker, Cumbers, Burns or the combinations of Walker, Cumbers, and Burns can't be said to render obvious the invention as recited in claims 42, 43, 54, 56 and 57 and the objection is believed overcome thereby.

The Examiner rejected claims 47 under U.S.C. 103 (a) as being unpatentable over Walker et al. and Cumbers as applied to claim 36, and in further view of Kelly (US Patent No. 5, 816, 918). The rejection is respectfully traversed.

As described above, Cumbers teaches away from the present invention as recited in claims 36 and thus the combination is improper. Therefore, for at least the reasons recited above, Walker, Cumbers and Kelly or the combination of Walker, Cumbers and Kelly can't be said to render obvious the invention as recited in claim 47 and the objection is believed overcome thereby.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
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